

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1, 3-7, 9-14, 22 and 23 have been rejected.

Claims 1, 7 and 23-24 have been amended.

Claims 1, 3-7, 9-14, 22 and 23 are pending in this application.

Substantive Matters

Claims 1, 5-7, 11-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Messiet (US 5,875,404) in view of Martineau (US 5,915,226). This rejection is respectfully traversed.

The independent claims, 1, 7, 23 and 24 have been amended to specify the particular steps involved during the powering-down function of the communication device. Support for this can be found in the specification describing FIG. 4 (page 5 line 20 to page 6 line 5). In particular, when a user presses the power button of the device; the second SIM is disconnected, the first SIM is connected, the first SIM is updated through a communication, the first SIM is disconnected, the second SIM is reconnected, and the device is finally turned off.

Messiet discloses the use of two SIM cards, one of which supercedes the other. The only transfer of responsibilities between cards occurs when a user manually changes one of them. Messiet does not suggest or disclose transferring of operation between cards during depowering. Therefore, Messiet could not suggest or disclose applicants' inventive technique to transfer functions automatically during depowering, as recited in amended claim 1.

Similarly, Martineau discloses the use of two SIM cards with different functions. Although Martineau does disclose manual card insertion, Martineau discloses even less of the transfer responsibilities between card insertions than Messiet. In addition, Martineau does not suggest or disclose transferring of operation between cards during depowering. Therefore, Martineau could not suggest or disclose applicants' inventive technique to transfer functions automatically during depowering, as recited in amended claim 1.

Although, applicant is willing to submit that there are devices that do not immediately power down when the power button is pushed, this is merely a timing feature to allow time to complete an ongoing function. Applicants' invention is quite different in that there is much more going on during the powering down phase than just waiting for a set time to complete an ongoing function. Specifically, after the power off operation is started, the second SIM card is disconnected, the first SIM card is connected, and a communication (such as an external GSM communication) is initiated and performed that involves updating information on the first SIM

card, whereafter the first SIM card is disconnected, the second SIM card is reconnected, and the device is powered down, all without user intervention.

The cited art does not suggest or disclosed any of these newly performed automatic actions during a power down mode. Applicants submit that the provision for these many steps, in the order presented is novel and distinct from the cited art, and that these are far too many steps to be rendered obvious from the cited art.

Moreover, although the Examiner takes Official Notice of a delayed power down feature, there has been no art cited with any of the novel steps taken by applicants' invention during a powering down procedure. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. In fact, many of the claim limitations are missing from the cited art. Thus, neither the Messiet, Martineau, nor even the Examiner's Official Notice clearly renders obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the applicants' specification, it is a benefit to use the claimed invention because it permits the seamless transfer of information between SIM cards during a period of time when a user would not normally be needing the device. None of the cited art, for the reasons mentioned above, suggests the desirability of the claimed invention since each of them require some user intervention to change cards.

Applicants' specification specifically teaches how to obtain the seamless transfer of information between SIM cards without user intervention. Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

Therefore, applicants respectfully submit that amended claims 1, 7, 23 and 24 are now in a condition for allowance.

Pending claims 3-6 and 20-22 depend on amended independent claim 1, hereby incorporated by reference, and are therefore deemed allowable as well for the same reasons.

Pending claims 9-19 depend on amended independent claim 7 hereby incorporated by reference, and are therefore deemed allowable as well for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Claims 15-22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Messiet in view of Martineau as applied to claims 1 and 7 above, and further in view of Siccardo et al. (US 6,115,605). This rejection is respectfully traversed.

Claims 15-19 and 20-22 are dependent on claims 7 and 1, respectively, and therefore include all of the recitations of those claims, which are hereby incorporated by reference and which have been previously distinguished, and thereby deemed allowable as well for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

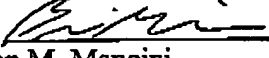
No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection or through an Examiner's amendment.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

Respectfully submitted,
Howell et al.

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